

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

OCT 31 2007

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte : EDWARD JAMES CARGILL

Application No. 10/769,761

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on October 2, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

APPEAL BRIEF

Grounds of Rejection to be Reviewed on Appeal

Appellant filed an Appeal Brief November 1, 2006, in response to a Final Rejection mailed April 4, 2006. In the "Grounds of Rejection to be Reviewed on Appeal" section of the brief a statement of each grounds of rejection was listed however, for "grounds 1 and 2" the 103(a) statute was not included in the statement. 37 CFR 41.37(c)(1)(vi) states:

***>(vi) Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.< For example, the statement ** "Whether claims 1 and 2 are unpatentable" would not comply with **>the rule, while the statements< "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones," *>and< "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure" **>would comply with the rule. The statement cannot

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include any argument concerning the merits of the ground of rejection presented for review. Arguments should be included in the "Argument" section of the brief.<

Claims Appendix

A review of the file reveals that claim 1 in the appendix of the Appeal Brief is not consistent as amended in the Amendment filed on January 11, 2006. The Appeal Brief Appendix of Claims (claim 1, page 29, line 5-6, 12 and 19) contains phrases that were previously deleted in the Amendment filed January 11, 2006. Corrective action is required.

INFORMATION DISCLOSURE STATEMENT

Appellant filed an Information Disclosure Statement (IDS) dated July 11, 2006 and August 21, 2006. There is no indication on the record that the above Information Disclosure Statement was considered by the Examiner.

MPEP § 609 requires the Examiner to consider any Information Disclosure Statement filed by Applicant if timely submitted. A written communication notifying appellant of the Examiner's consideration of the above Information Disclosure Statement is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

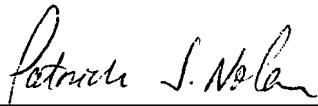
1) hold the Appeal Brief filed November 1, 2006, defective;

2) notify the appellant to submit a "paper" which corrects the Appeal Brief, Grounds of Rejection to be Reviewed on Appeal as required under 37 § 41.37(c)(1)(vi) and the Claims Appendix;

- 3) for the examiner to acknowledge and consider any "paper" that may be submitted by Appellant in response to the Notice of Non-Compliance;
- 4) consider the IDS filed July 11, 2006 and August 21, 2006 and notify appellant; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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By:



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PJN/tsj

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